



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/448,420	11/22/1999	MICHAEL SEUL	42970-3	5017
23973	7590	12/23/2003		
DRINKER BIDDLE & REATH ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996				
			EXAMINER PONNALURI, PADMASHRI	
			ART UNIT 1639	PAPER NUMBER

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/448,420

Applicant(s)

SEUL ET AL.

Examiner

Padmashri Ponnaluri

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 129-151, 154-166 and 168-174.Claim(s) withdrawn from consideration: 152-153, 167.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER

Padmashri Ponnaluri  
Primary Examiner  
Art Unit: 1639

**ADVISORY ACTION (continued)**

The second after final response filed on 11/20/03 has been received in this application.

The proposed amendment filed on 11/20/03 has not been entered into the application for the following reasons:

- a) The proposed amendment to claim 129 does not overcome the rejections of record.

Applicants have proposed to add 'by in-situ optical interrogation of the tags to provide chemical identity,' which would not overcome the art rejections of record.

As addressed in the previous advisory action the word "identity" of the compound does not include determining the sequence or structure of the compound' as in applicants arguments.

The prior art of record (Boyce et al, or Still et al or Dower et al) identifies the positive compounds by picking up bright red beads. Thus the reference picking up bright red beads refers to in-situ optical interrogation of the tag to provide the chemical identity of the compound.

And Dower et al identifies the fluorescent beads manually which would read on 'in-situ optical interrogation to provide chemical identity' (positive compounds) of the instant claims.

Applicants argue that Still et al (US Patent 5,968,736) does not disclose 'decoding step is carried out without isolating the solid support.' Applicant's arguments have been considered and are not persuasive. The instant claim recites 'decoding the code composed of one or more tag(s) by in-situ optical interrogation of the tag(s) to provide the chemical identity', in which the 'decoding step' is considered as comprising 'in-situ optical interrogation of the tag to provide the chemical identity of the compound.' Still et al clearly anticipate the limitation by reciting fluorescent beads with the compounds of interest are identified manually' which reads on 'in-situ optical interrogation of the tag (fluorescence) to provide the chemical identity of the compound

Art Unit: 1639

(compound of interest). Thus the proposed amendment would not overcome the rejections of record.

b) The proposed amendment would raise new issues under 35 USC, 112 second paragraph, since the term 'identity' is indefinite and open, and the reference identification of the compounds of interest bound to the fluorescent bead or bright red beads with the compounds attached would read on the limitation. As in applicants response 'the chemical identity' does not refer to sequence information or structural information of the compound. E.g., the references teach identifying (or picking) the positive compounds (compounds of interest), thus the chemical identity of the compounds (either as receptors or inhibitors of the ligand or antigen or antibody) is known, which refers to chemical identity of the compound. Thus the proposed amendments would raise new issues.

The reasons discussed above the proposed amendments have not been entered into the application.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on Flex Schedule and can normally reached from Monday through Friday between 7.30 AM and 4.00 PM..

Application/Control Number: 09/448,420

Page 4

Art Unit: 1639

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Padmashri Ponnaluri  
Primary Examiner  
Art Unit 1639

Pp  
12/19/03